

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

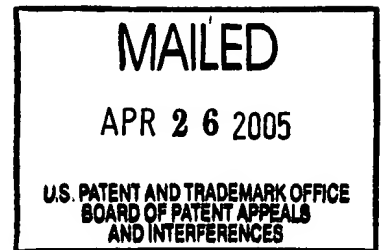
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte ANDREW F. SUHY, JR.

Appeal No. 2005-0013  
Application No. 09/653,735

ON BRIEF



Before BARRETT, BARRY, and LEVY, Administrative Patent Judges.  
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-8 and 12-24, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to an apparatus and method for tracking and managing physical assets. An understanding of the

invention can be derived from a reading of exemplary claim 1,  
which is reproduced as follows:

1. A system for gathering and analyzing data relating to a  
non-fixed movable asset comprising:

a local controller located at a first location for acquiring  
data that is representative of at least one operating  
characteristic of the asset;

an analysis controller located at a second location that is  
responsive to said acquired data from said local controller for  
generating an analysis of said acquired data; and

an electronic communications network connected between said  
local controller and said analysis controller and permitting  
transmission of said acquired data from said local controller to  
said analysis controller; and

a sub-system that analyzes said at least one operating  
characteristic of the asset to determine a lease rate for the  
asset, the lease rate being a variable.

The prior art references of record relied upon by the  
examiner in rejecting the appealed claims are:

Koether	5,875,430	Feb. 23, 1999
Nguyen et al. (Nguyen)	6,003,808	Dec. 21, 1999 (Jul. 11, 1997)
Albertshofer	6,230,081	May 8, 2001 (Aug. 7, 1998)

Claims 1-7 and 12-24 stand rejected under 35 U.S.C. § 103(a)  
as being unpatentable over Koether in view of Albertshofer.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being  
unpatentable over Koether in view of Albertshofer and Nguyen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 16, mailed May 17, 2004) for the examiner's complete reasoning in support of the rejections, and to appellant's brief (Paper No. 15, filed February 17, 2004) and reply brief (Paper No. 17, filed July 19, 2004) for appellant's arguments thereagainst. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii).

#### OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we reverse, essentially for the reasons set forth by appellant. We begin with the rejection of claims 1-7 and 12-24 under 35 U.S.C. § 103(a) as being unpatentable over Koether in view of Albertshofer. We turn first to independent claims 1, 13 and 18.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings

by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, pages 5 and 6) is that Koether does not explicitly recite determining a lease rate. To overcome this deficiency of Koether, the examiner turns to Albertshofer for a teaching of an asset usage monitoring system that monitors asset performance over time for determining a lease rate. In addition, the examiner (id.) relies upon Webster's Ninth College Dictionary for a definition of "rate" which is defined as "'a quantity, amount, or degree of something measured per unit of something else'." The examiner asserts (id.) that it would have been obvious to calculate a rate based on any quantity, amount or degree of something within the scope of knowledge and understanding of an artisan, such as owners of

equipment who also maintain the equipment that they lease to others. The examiner adds that it would have been obvious to combine the systems of Koether and Albertshofer in order to accurately determine fees for the rental and leasing of capital equipment.

The examiner additionally asserts (answer, page 9) that appellant has not made clear how "rate" is defined beyond the lease rate being a variable, and that in Albertshofer the lease rate is a variable as it is based on usage. It is further argued (id.) that appellant's specification does not support as specific a definition of rate as set forth in the brief.

Appellant asserts (brief, page 9) that the prior art does not teach or suggest the claim limitation of an analysis of "at least one operating characteristic of the asset to determine a lease rate for the asset," because the prior art doesn't teach determining a lease rate as recited in claims 1, 13 and 18. It is further argued (brief, page 10) that Albertshofer teaches calculating a total lease amount based on usage duration of the vehicle or the distance it has gone, and that Albertshofer's rate is a constant independent of an operating characteristic. It is argued that Albertshofer does not teach determining a lease rate for an asset, much less determining a lease rate based on an

analysis of an operating characteristic of the asset. Appellant asserts that Albertshofer's disclosure is directed toward one-time usage of a golf cart, and that if a user rents the cart at an hourly rate of \$10, then renting it for two hours results in a total lease amount of \$20. Appellant adds that Albertshofer's rate is a constant multiplied by the variable operating characteristic, which is a usage duration, e.g., \$10 per hour. It is further asserted (id.) that in appellant's invention, the rate is a variable affected by an analysis of at least one operating characteristic. Appellant states (brief, page 11) that "Albertshofer does not teach determining a lease rate that can then be used as a variable in the calculation of the amount to be charged for a lease."

Appellant further asserts (brief, page 12) that there is no motivation to combine the teachings of Koether and Albertshofer. It is argued that "[t]he examiner provides no explanation as to why one of ordinary skill in the art would have been motivated by the cited references *to analyze an operating characteristic of an asset to determine a lease rate for the asset*. Moreover, the cited references provide no motivation for their combination." Furthermore, with regard to claim 18, appellant adds (id.) that neither reference discloses the claim limitation of "maintenance

information affecting said lease rate." It is argued (brief, page 13) that although Albertshofer discloses using service manuals to assist in automating vehicle maintenance, Albertshofer does not teach using maintenance information to determine a lease rate.

Upon careful review of Koether, we find the reference to be silent as to leasing of the disclosed kitchen appliances, and the examiner has failed to point to any suggestion in the reference that the kitchen appliances can be leased. Because Koether is completely silent as to leasing of the kitchen appliances, we find no teaching or suggestion to combine the teachings of Koether and Albertshofer as advanced by the examiner. However, we find Albertshofer to be closer to the claimed invention than the examiner recognized. Considering Albertshofer alone, we find that Albertshofer discloses an information system for displaying data on a golf cart (col. 1, lines 5-7). Albertshofer discloses that it is known to lease electric or engine-powered equipment in order to save on investment costs (col. 4, lines 9-12). Accounting for such services is generally done in a time-dependent fashion, or can be duty-dependent as a function of duration and intensity of use (col. 4, lines 12-15). It is



disclosed that if the duty-hour counter or distance-gone counter is tampered with, the result may be that the true wear and tear of the equipment exceeds the level as calculated by the leasing company on the basis of the information received (col. 4, lines 16-23). From the disclosure that accounting services are based on time dependency, or duration and intensity of use, and the disclosure suggesting that leases are calculated based on estimated wear and tear of the product, we find that Albertshofer teaches the determination of a lease rate by the leasing company, that is based upon operating characteristics.

In addition, from the disclosure of wirelessly transmitting collected data from the power equipment to the base station, we find teachings of a local controller on the power equipment, an analysis controller in the form of the base station, and an electronic communications network in the form of wireless communications between the power unit (golf cart) and the base station (col. 3, lines 40-43). Albertshofer additionally discloses (col. 5, lines 23-26) that "[v]ehicles, machines and equipment of all kinds, be they electrically powered, engine powered or pneumatically/hydraulically powered, as well as lifting platforms and, for instance, golf carts are suitable as

such equipment items." From the disclosure that the system can be used with a hydraulically-powered lifting platform, we find that Albertshofer suggests using the system with a forklift, as disclosed by appellant.

However, although Albertshofer teaches or suggests determining a lease rate, we find no suggestion of a sub-system in Albertshofer for carrying out the determination of the lease rate. We presume that the information gathered by the base station is somehow used by the leasing company, through their accounting methods, to determine the lease rate. However, no sub-system is disclosed for analyzing the collected data from the golf cart or other equipment and using this analyzed data in determining the lease rate. Accordingly, we find that Albertshofer alone is not sufficient to teach or suggest appellant's independent claims 1, 13 and 18 which recite a sub-system for using the operating characteristic in determining the lease rate. Thus, because Albertshofer does not disclose the claimed sub-system, Albertshofer does not teach or suggest independent claims 1, 1 and 18. The rejection of independent claims 1, 13 and 18 under 35 U.S.C. § 103(a), and claims 2-7, 14-17, 12 and 21-24, dependent therefrom, is reversed.


We turn next to the rejection of claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Koether in view of Albertshofer and Nguyen. We cannot sustain the rejection of claim 8 because the examiner has not shown, nor do we find, that Nguyen makes up for the basic deficiencies of Koether and Albertshofer. Accordingly, the rejection of claim 8 under 35 U.S.C. § 103(a) is reversed.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 1-8 and 12-24 under 35 U.S.C. § 103(a) is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136 (a)(1)(iv) (effective September 13, 2004; Fed. Reg. 49960 (August 12, 2004)).

LEE E. BARRETT

  
 LANCE LEONARD BARRY  
 Administrative Patent Judge

STUART S. LEVY

SSL/kis

Appeal No. 2005-0013  
Application No. 09/653,735

Page 13

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